

Atty Dkt. No.: 10030468-1
USSN: 10/686,092**RECEIVED**
CENTRAL FAX CENTER
NOV 02 2006**REMARKS**

In view of the above amendments and the following remarks, the Examiner is requested to allow claims 1-4, 6-20 and 28-30, the only claims pending and under examination in this application.

Claim 1 has been amended to incorporate the elements of Claim 5 therein, and Claim 5 has been cancelled. Claim 6 has been made dependent upon Claim 1. Claims 10 and 12 have been amended to recite *conditions* rather than *sets*. Support for this change appears in original Claim 5, for example. The spelling of *across* has been corrected in Claim 10, and the spelling of *plurality* has been corrected in Claim 12. Claim 17 has been written in independent form. Claims 21-25 have been cancelled. New Claims 26-30 have been added. Support for these claims appear in the original claims and in the specification, particularly at page 10, lines 15-20.

No new matter has been added.

RESTRICTION REQUIREMENT

Applicant requests withdrawal of the finality of the restriction requirement and rejoinder of Group II, Claims 17-20, with elected Group I. As a result of the amendment to Claims 1 and 17, Groups I and II are now drawn to patentably indistinct methods involving virtually identical method steps. Applicant submits that there is no serious search burden in examining Claims 17-20 with the elected claims

INTERVIEW SUMMARY

Applicant wishes to thank the Examiner and his mentor for extending the courtesy of a personal interview to Applicant's representative, Richard A. Schwartz, on October 13, 2006.

Possible claim amendments that might overcome the rejection under 35 U.S.C. § 101 were discussed. The Examiner also pointed out what he considered to be the salient aspects of the enablement rejection.

This account is believed to be a complete and accurate summary of the interview as required by 37 C.F.R. § 1.133. If the Examiner believes that this

Atty Dkt. No.: 10030468-1
USSN: 10/686,092

summary is inaccurate or incomplete, Applicant respectfully requests that the Examiner point out any deficiencies in his next communication so that Applicant can amend or supplement the interview summary.

Claim Rejections – 35 U.S.C. § 101

Claims 1-4 and 7-16 were rejected under 35 U.S.C. § 101 as allegedly being drawn to non-statutory subject matter. This rejection is respectfully traversed.

The claims were rejected for allegedly not resulting in a physical transformation of matter or a practical application. Present claims 1-4 and 7-16 now include the elements of Claim 5, which was not subject to this rejection. This aspect of the rejection may be withdrawn.

Claim 15 was rejected based on the Examiner's assertion that *computer readable medium* is not defined in Applicant's specification to be a physical object. Applicant respectfully directs the Examiner's attention to page 10, lines 25-30 of the specification.

Similarly, Claim 16 was rejected based on the Examiner's assertion that the system comprising a computer readable medium encompasses only software. Applicant again respectfully directs the Examiner's attention to page 10, lines 25-30 of the specification.

Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 112, first paragraph

Claims 1-16 were rejected under 35 U.S.C. § 112, first paragraph, as allegedly failing to comply with the enablement requirement. This rejection is respectfully traversed.

The Examiner asserted that the specification does not define *experimental sets* and *empirical data values* in Claim 1 and how one would identify and obtain such sets. Present Claim 1 recites experimental conditions, which are described in the specification at page 16, for example. That section discloses that a plurality of differential gene expression experiments is used to obtain empirical performance data values for each of the candidate nucleic acid probe sequences for each of the plurality of different conditions.

Atty Dkt. No.: 10030468-1
USSN: 10/686,092

The Examiner also asserted that it is unclear how sequences can satisfy a signal intensity threshold. Applicant respectfully directs the Examiner's attention to pages 23 and 24 of the specification for a description of this aspect of the invention.

Accordingly, Applicant's specification describes the claimed invention in such a manner that the invention may be practiced without undue experimentation. Withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. § 112, second paragraph

Claims 1-16 were rejected under 35 U.S.C. § 112, second paragraph for alleged indefiniteness. This rejection is respectfully traversed.

With respect to Claim 1, the Examiner asserted that the final method step does not result in the method stated in the preamble. Applicant respectfully directs the Examiner's attention to the last three lines of Claim 1, which recite *to identify any candidate probe sequences of said plurality that are suitable for use as a substrate surface immobilized normalization probe*. This recitation is in agreement with the preamble of the claim. This aspect of the rejection may be withdrawn.

The Examiner asserted that the meaning of *experimental sets* in Claim 1 is unclear. The claims now recite *experimental conditions*. This aspect of the rejection may be withdrawn.

The Examiner asserted that it is unclear from Claim 1, step (b) in what way the evaluated probe sequences are further limited. Applicant submits that further limitation is not necessary within a claim. As the claims now recite *experimental conditions*, the Examiner's view of the claims may now be different. Clarification is requested.

The Examiner also asserted that it is unclear in Claim 1, step (b) for what the collection of data is obtained. The data are clustered in step (c) and ultimately used for the purpose set forth in the preamble. This aspect of the rejection may be withdrawn.

The Examiner asserted that it is unclear from the phrase *evaluating any remaining non-clustering probes* in Claim 1, step (d) what method of evaluation is employed. The phrase at issue is followed by *for candidate probe sequences that*

Atty Dkt. No.: 10030468-1
USSN: 10/686,092

satisfy a signal intensity threshold and exhibit substantially no variation in signal under said plurality of different experimental conditions. Signal intensity threshold is described in Applicant's specification at page 23, for example. It is well-established that definiteness of claim language is not analyzed in a vacuum, but rather in light of the specification, *inter alia*. MPEP §2173.02. This aspect of the rejection may be withdrawn.

The Examiner asserted that the phrase *any remaining non-clustering probes* in Claim 1, step (d) lacks antecedent basis within Claim 1. Basis may be found in clustering step (c), since any probes that are not clustered into groups are non-clustered. This aspect of the rejection may be withdrawn.

The Examiner also asserted that it is unclear how the phrase *any remaining non-clustering probes further limits the candidate probes*. Applicant again submits that further limitation is not necessary within a claim. The non-clustering probes are evaluated for the purpose set forth in the preamble. As such the claim language is definite. This aspect of the rejection may be withdrawn.

The Examiner asserted that it is unclear to what the word *plurality* in Claim 1, step (d) refers. Claim 1 recites only two pluralities, namely candidate probe sequences in step (a) and different experimental conditions in step (b). It is clear from context that *plurality* in step (d) refers to the plurality of candidate probe sequences in step (a). This aspect of the rejection may be withdrawn.

The Examiner asserted that it is unclear whether Claim 3 represents an additional method step or a further limitation of parent Claim 2. Applicant presumes that the Examiner is referring to Claim 2 and to parent Claim 1. The plain language of Claim 2 indicates that the selection criteria set forth therein further limit Claim 1, step (a). This aspect of the rejection may be withdrawn.

Applicant does not see any grammatical error in Claim 3, as noted by the Examiner. Clarification is requested.

The Examiner asserted that *experimental conditions* in Claim 5 lacks antecedent basis in Claim 1. As Claim 1 now recites *experimental conditions* and Claim 5 has been cancelled, this aspect of the rejection may be withdrawn.

The Examiner asserted that it is unclear in Claim 6 whether *tissue/cell line* is one or the other or both. Applicant's have used the slash mark (/) to separate

Atty Dkt. No.: 10030468-1
USSN: 10/686,092

alternatives, i.e. to mean "or." This is a standard usage of the mark in technical publications. See the APA and Sematech printouts, copies of which are enclosed for the Examiner's convenience. Note from Sematech that the slash is used only to separate *and* and *or* in the term *and/or*, i.e. the slash does not mean *and/or*. This aspect of the rejection may be withdrawn.

The Examiner asserted that Claim 7 step (i) is unclear for not reciting steps in the process. It is well-established that definiteness of claim language is not analyzed in a vacuum, but rather in light of the specification and the teachings of the prior art, *inter alia*. MPEP §2173.02. Applicant submits that steps for obtaining an expression vector are known in the art and need not be recited for the claim to be definite. This aspect of the rejection may be withdrawn.

Finally, the Examiner asserted that it is unclear whether the recitation in Claim 10 of *sequence is considered to exhibit* is a limitation of the intended method or an actual physical step. The plain language of the claim would not convey to the reader that an additional actual physical step is intended. Pursuant to 35 U.S.C. § 112, paragraph 4, a proper dependent claim further limits a claim previously set forth.

The Examiner also asserted that the intended meaning of *considered to exhibit* is unclear in Claim 10. The claim language conveys a decision making process employed by the person using the claimed method in evaluating a candidate probe sequence for exhibition of substantially no variation in signal based on the log ratio of the sequence. This aspect of the rejection may be withdrawn.

Withdrawal of this rejection is respectfully requested.

Atty Dkt. No.: 10030468-1
USSN: 10/686,092

RECEIVED
CENTRAL FAX CENTER

NOV 02 2006

CONCLUSION

Applicant submits that all of the claims are in condition for allowance, which action is requested. If the Examiner finds that a telephone conference would expedite the prosecution of this application, please telephone John Brady at (408) 553-3584.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078, order number 10030468-1.

Respectfully submitted,

Date: November 2, 2006

By: 

Richard A. Schwartz
Registration No. 48,105

Date: November 2, 2006

By: 

Bret E. Field
Registration No. 37,620

AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
P.O. Box 7599
Loveland, CO 80537-0599

F:\DOCUMENT\AGIL\139 (10030468-1)\10030468-1 (AGIL-139) ROA of 8-9-06.doc